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LEA/GAD #10

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(For Patent Owner)

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REEXAM UNIT

In re reissue application of	:	
Thompson	:	
Serial No. 09/014,518	:	
Filed: January 28, 1998	:	
For: U.S. Patent No. 5,472,790	:	DECISION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS
In re Thompson	:	
Reexamination Proceeding	:	
Control No. 90/004,752	:	
Filed: September 17, 1997	:	
For: U.S. Patent No. 5,472,790	:	

This is responsive to the NOTICE OF RELATED PROCEEDINGS AND PETITION TO MERGE PROCEEDINGS filed January 28, 1998, by Lawrence Maxwell, attorney for applicant, which requested the merger of the above reissue application and reexamination proceeding. Consequently, the above noted reexamination file and reissue application are before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for a decision on whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,472,790 issued December 5, 1995.
2. On September 17, 1997, a request for reexamination was filed by the third party requester.
3. On November 25, 1997, reexamination was ordered.

4. On January 14, 1998, a first Office action was issued in the reexamination proceeding which was later vacated on February 24, 1998, in view of the receipt of the Patent Owner's Statement and Amendment under 37 CFR 1.530 on January 26, 1998.
5. On January 28, 1998, a reissue application was filed<sup>1</sup>, including amendments to all nine patent claims and two additional claims.
6. On March 9, 1998, the third party requester filed a Reply to the Patent Owner's Statement.

#### DISCUSSION

Under 37 CFR § 1.565(d):

- (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. As the order to reexamine has been mailed in the reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reasons for this policy is to prevent inconsistent, and possible conflicting amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the proceedings consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue prosecution history shows that the announcement of the filing of the reissue application was published in the Official Gazette on March 24, 1998, thereby permitting the issuance of a first action on the merits after May 24, 1998. 37 CFR § 1.176. New claims have been added in the reissue application. A review of the reexamination file shows that the reexamination is awaiting an Office action by the examiner. Although patent owner amended his claims in the Patent Owner's Statement and Amendment filed January 26, 1998, the claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting amendments from being

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<sup>1</sup> It is noted that since the reissue application was not filed within the two year period provided by 35 USC 251, no "enlarging [of] the scope of the claims" is permitted.

introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexaminations will be in accordance with the decision set forth below.

### DECISION

#### I. Merger of Proceedings

The above noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

#### II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceedings. The maintenance of identical amendments in both files is required as long as the proceedings are merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within one month of this decision placing the same amendments in both proceedings. The patent owner should not address the issues of either proceeding in the housekeeping amendment.

#### III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

In view of the fact that the statutory provisions for reissue application examination include, inter alia, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader reissue application examination. The examiner will apply the reissue statute, rules and case law to the merged proceeding. The examiner's actions will take the form of a single action which jointly applies to both the reissue application and the reexamination proceeding. The action will contain identifying data for both the reissue application and the reexamination proceeding and will be physically entered into both files which will be maintained as separate files. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in both files. Any such responses must be served on the requester who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to

37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination should be withdrawn (e.g., based on public use or sale) and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If the reissue application ultimately matures into a reissue patent the reexamination proceeding shall be terminated by the grant of the reissued patent and the reissued patent will also serve as the certificate under § 1.570. See MPEP 2285.

Applicant/patent owner is advised that the filing of any continuation reissue application under 37 CFR § 1.53 will most likely result in the dissolution of the merged proceeding, a stay of the continuing reissue application, and separate, continued prosecution of the reexamination proceeding.

#### **IV. Remand for Examination**

The above noted reissue application and reexamination proceeding are merged. The reissue application and the reexamination file are being forwarded to Group Art Unit 1615 for examination in accordance with this decision.

Inquiries concerning this decision should be directed to the undersigned at (703)305-9285.



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